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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/840,670	04/23/2001	Edward O. Clapper	INTL-0539-US (P10899)	4133

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EXAMINER

PESIN, BORIS M

ART UNIT	PAPER NUMBER
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2174

DATE MAILED: 12/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application N .

09/840,670

Applicant(s)

CLAPPER, EDWARD O.

Examin r

Boris Pesin

Art Unit

2174

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_ 6) ☐ Other:

## **DETAILED ACTION**

### ***Specification***

The disclosure is objected to because of the following informalities:

Throughout the specification, the inventor refers to details on the drawings, but does not specifically disclose which elements he is referring to. The problem occurs with elements 26, 28, and 30. Those elements have depending elements, A-D. If the inventor chooses to refer to multiple elements, he should disclose so by stating, for example, elements 26A-D.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim 1-10, 13-22, and 24-28 are rejected under 35 U.S.C. 102(e) as being anticipated by Evans (US 6347329).

In regards to claim 1, Evans discloses a method for providing a plurality of user selectable message options and enabling the user to compile a message by selecting from among the available message options. (Figure 3, Elements 120-129).

In regards to claim 2, Evans discloses a method for providing message options that include displaying a graphical user interface listing a plurality of message options.(Figure 3, Element 127).

In regards to claim 3, Evans discloses a method for providing a plurality of pre-selected display segments and providing a plurality of user selectable options for each segment. (Figure 3, Elements 121-127).

In regards to claim 4, Evans discloses a method that includes displaying a list of user-selectable options for plurality of display segments. (Figure 3, Elements 127 and 129).

In regards to claim 5, Evans discloses a method for enabling the options to be displayed as a list of options. (Figure 3, Element 127).

In regards to claim 6, though Evans does not specifically disclose the method of enabling the user to mouse select an option from each of the plurality of lists to complete a message, it is inherent in the invention that it is possible to do so.

In regards to claim 7, Evans discloses a method that includes displaying a graphical user interface in association with each of a plurality of display segments. (Figure 3, Elements 121-129).

In regards to claim 8, Evans discloses a method for including linking a list of options to a display segment so that when an option is selected it appears on a display associated with a particular display segment. (Figure 3, Element 127).

In regards to claim 9, Evans discloses a method that includes generating an interface displaying said options and conveying said interface to a local system over a network. (Figure 3, and Figure 24).

In regards to claim 10, Evans discloses a method that includes generating a graphical user interface to locally display the options, developing the message locally, and transmitting the message remotely over a network. (Figure 3, Figure 24).

Claims 13-22 are in the same context as claims 1-10; therefore they are rejected under similar rationale.

Claims 24-26 are in the same context as claims 1-3; therefore they are rejected under similar rationale.

In regards to claim 27, Evans discloses that his invention consists of a server (Figure 3, Element 414).

In regards to claim 28, Evans discloses that his invention consists of a client (Figure 3, Element 416).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 2174

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 11, 12, 23, 29, and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Evans (US 6347329) in view of Pelletier et al. (US 6327354).

In regards to claim 11, Evans discloses all the limitations of claim 1, but lacks a method for audibly providing a plurality of user selectable message options. Pelletier teaches that, "... if the server ... includes a voice recognition resource, the audio message may provide options in the form of 'press or say' a digit to call a desired destination, or to select an option." (Column 5, Line 44). Pelletier explains that you can have different options for messages. It would have been obvious to one of ordinary skill in the art at the time of the invention to use Pelletier's teaching and modify Evans' invention accordingly to include a method for playing the different message options audibly in order to facilitate the creation of messages.

Claim 12 additionally recites, the method to compile a message by selecting from among available audible message options by making key selections on a telephone. Pelletier teaches, that, "... the audio message may provide options in the form of 'press or say' a digit to call a desired destination, or to select an option." (Column 5, Line 44).

Art Unit: 2174

Claim 23 is in the same context as claim 11; it is therefore rejected under similar rationale.

Claim 29 is in the same context as claim 11; it is therefore rejected under similar rationale.

Claim 30 is in the same context as claim 12, except that it further elaborates that there exists a telephone network. It is inherent in the invention of Evans and Pelletier, as described in the rejection for claim 12, that a telephone network exists.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US005602963A	Bissonnette et al.
US006345273B1	Cochran
US005805164A	Blum et al.
US005973613A	Reis et al.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Boris Pesin whose telephone number is (703) 305-8774. The examiner can normally be reached on Monday-Friday except for every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kristine Kincaid can be reached on (703) 308-0640. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Art Unit: 2174

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

*Kristine Kincaid*  
KRISTINE KINCAID  
SUPERVISORY PATENT EXAMINER  
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